Section III:

AMENDMENT UNDER 37 CFR §1.121 to the

DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:

AMENDMENT UNDER 37 CFR §1.121

REMARKS

Request for Telephone Interview

Applicants' representative requests a telephone interview with the examiner following receipt of the present reply and amendment in order to answer any questions the examiner may have, and to consider any suggestions the examiner may offer.   Applicant's agent, Robert H. Frantz, can be reached at 405-812-5613, by the examiner to indicate the examiner's choice of time and date for the telephone interview.

Rejections under 35 U.S.C. §101

In the Office Action, claims 1 - 7 have been rejected under 35 U.S.C. §101 for being directed to non-statutory matter.   In the rationale for the rejections, it is agreed that Claim 1 recites a logical device, but goes on to state "However, the device as recited can be entirely embodied in software per se. Software is considered to represent non-statutory matter." The quote from MPEP 2106 provides no statutory authority for rejecting a claim which is directed towards a device, but in which the examiner believes the invention could be embodied entirely in software.

Claim 1, from which claims 2 - 7 depend, specifically claims the following tangible items as being directed towards a "logical device", which is in and of itself tangible: (a) a "Real-time Attribute Processor", (b) an "RTAP selector", and (c) a "directory attribute processor". These are illustrated in the figures, and are described in the disclosure as a portion of and cooperative with a server system, such as an LDAP directory server, which is also tangible.

The mere fact that an invention may be alternatively completely embodied in software is not a valid ground for rejection, unless the claims are directed towards such an alternative software-only embodiment. The basis for rejecting software under §101 where the software is not claimed with any tangible device, such as a memory or processor, derives from the concept of non-functional descriptive material and abstract ideas being non-patentable.

However, in the instant case, the claims set forth a "logical device" which has certain components, and thus is not "descriptive material", nor is it an abstract idea.

If it were true that a claim could be rejected on the basis that it could be re-embodied an abstract idea, such as software alone, then conceivably no inventions would be patentable because all inventions start with a concept or spark of genius in the mind or minds of the inventors. Therefore, there is no such basis for a rejection of a claim which is not drawn towards software but instead is drawn to a device.

For these reasons, the rejections of claims 1 - 7 are improper and are not authorized by 35 U.S.C, 37 C.F.R, or by Policy of the USPTO. Applicants request withdrawal of the rejections on these grounds.

Further, claims 1 - 7 recite significant structural interaction and specialized apparatus (e.g. processors, selector, etc.), and thus are directed towards patentable matter. *In re* Iwahashi, 888 F.2d 1370, 12 USPQ2d 1908 (Fed. Cir. 1989).

And, whereas access requests in computer networks such as LDAP access requests involve electronic and/or optical signals, and whereas Claim 1 transforms those physical signals, Claims 1 - 7 are directed towards patentable matter. Arrhythmia Research Tech., Inc., v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992).

Still further, the invention set forth in Claims 1 - 7 is limited to a meaningful field of use (e.g. handling requests for access to a directory of computer resources), and thus they are directed towards patentable matter. *In re* Noll, 545 F.2d 141, 191 USPQ 721 (C.C.P.A. 1976), *cert. denied*, 434 U.S. 875, 195 USPQ 465 (1977).

For these additional reasons, the rejections of Claims 1 - 7 under 35 U.S.C. §101 should be withdrawn.

Rejections under 35 U.S.C. §103

In the Office Action, claims 1 - 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Published Patent Application 2002/0147857 to Sanchez, II, et al. (hereinafter "Sanchez") in view of US Published Patent Application 2002/0061741 to Leung, et al. (hereinafter "Leung").

Applicants note that both of these references were supplied by Applicants via initial Information Disclosure Statement.

In the rationale for these rejections, the examiner has noted and agreed that, although Sanchez teaches certain aspects of mapping attributes to LDAP-type computer file directories,

Sanchez fails to explicitly disclose handling of dynamic attribute values. However, it was reasoned that Leung teaches such handling of dynamic attributes to process real-time data.

Sanchez in view of Leung Would Not Be Obvious to Combine - "Directory" Terms Misinterpreted

Sanchez is directed towards processing and operations related to computer resource "directories", such as directories which contain folders, files, sub-directories, etc.

Please note that Applicants have claimed "a directory attribute processor configured to parse requests for access to directory attribute values" in independent Claim 1, and similarly "parsing requests for access to directory attribute values to detect requests for attributes . . ." in independent Claims 8 and 14.

By "directory" and "requests for access to directory attribute values", Applicants are referring to a directory of computer network resources, not to a directory service which helps locate a mobile device and to direct the flow of information to that mobile device. This is consistent with Applicants' disclosure, especially with reference to discussion of LDAP and X.500, which are a computer directory terms, not a mobile telephone network terms. Specifically, Applicants have described and illustrated directories and directory access protocols as networked computer resources such as files, folders, databases, etc. (see especially paragraph [0007] and Figure 1).

Applicants' use of the term "directory" and "directory access requests" are consistent with one usage of the term in the industry, as evidences by an extrinsic definition of "Directory Service" which supports the dual, but disparate, definitions of "Directory Service":

Directory Service

    1. A simple term for the information service which the telephone company runs on 411 or 555-1212.

    2. A computer networking term. The facility within networking software that provides information on resources available on the entwork, including files, users, printers, data sources, applications, and so on. The directory service provides users with access to resources and information on extended networks.

    (Source: Newton's Telecom Dictionary, 18th Edition, by Harry Newton, February 2002, CMP Books)

As such, there are more than one definition of "directory" or "directory service", and the inventors have employed the terms within one of the normal meanings.   When there is more than one conventional meaning of a term or phrase in a claim, the Applicants are allowed to indicate which meaning is to be used in the interpretation of the scope of the claims, and examination should proceed according to that meaning.   *Ex parte* Saceman, 27 USPQ2d 1472 (B.P.A.I. 1993).   In this case, the Board recognized that in such a case of multiple, convention definitions for a single term or phrase, the Applicants may rely on one of the definitions if they clearly indicate the intended meaning of the term.

Further, the Court has indicated that it is entirely proper to use the specification to interpret what the applicant meant by a word or phrase in the claim.   E. I. Du Pont de Nemours & Co. V. Phillips Petroleum Co., 849 F.2d 1430, 7 USPq2d 1129, 1131 (Fed. Cir.), *cert. denied,* 488 U.S. 986 (1988).

Leung's "Directory Service" is not referring to such computer resource directories of files, folders, etc., but is instead referring to directory services in mobile networks (e.g. wireless telephone networks).   In a mobile telephone network, a directory service apparently helps provide a location of a terminal (e.g. which cell it is located in) so that calls, messages, etc., can be directed to that cell for that terminal.   For example, see Fig. 3 which shows maps of cells, interstates, etc., para. [0003] reference to "motorist" needing road conditions to his or her, and paragraphs [0018] and [0019] which describe a "directory service (DS)" that helps "locate" terminals using things like Global Positioning Service.   It would be improper to read the Applicants' definition of the term into the disclosure of Leung, of course.

As such Leung is directed towards handling and directing of real-time data from a source to a terminal, but not towards integrating that handling into protocol requests to a computer resource directory such as an LDAP or X.500 directory request.   Instead, Leung's "directory service" helps locate which cell a terminal is located in.

For these reasons, Sanchez in view of Leung does not teach all of the claim elements, steps, or limitations when the claim terms are given the meanings intended by the Applicants.

Not Obvious to Combine Sanchez with Leung Can Not Exist Whereas a Principle of
Operation of the Primary Reference Would Be Changed

The proposed combination would change a principle of operation of the primary
reference, and thus fails to support a rejection under MPEP §2143.01, which states:

> If the proposed modification or combination of the prior art would change
> the principle of operation of the prior art invention being modified, then
> the teachings of the references are not sufficient to render the claims
> *prima facie* obvious.

There would have been no motivation to combine Sanchez and Leung as proposed
because it would have modified the primary reference, Sanchez, to operate to locate mobile
devices. Sanchez had no such principle of operation, and thus a principle of operation of
Sanchez would be modified by the proposed combination.

Lack of *Prima Facie* Showing Regarding Motivation

In the Office Action, the motivation for combining Sanchez and Leung is insufficient to
establish a *prima facie* case of obviousness. The motivation is simply cited as "One would have
been motivated to [make this proposed combination] in order to improve the efficiency when
processing real-time data".

There is no citation where this motivation is stated in either Sanchez or Leung.
Applicants request withdrawal of the rejections or substantiation of where such motivation is
found.

<u>Lack of *Prima Facie* Showing Regarding Enablement</u>

For Applicants' claims to be obvious over Sanchez and Leung, a *prima facie* case of obvious must include disclosure within the references which would enable the proposed modifications. However, there is no citation in the Office Action as to where such enabling disclosure to use the features of Leung in Sanchez is found.

Applicants request withdrawal of the rejections or substantiation of where such enabling disclosure is found.

For these reasons, allowance of Claims 1 - 19 is requested.

Respectfully,

/ *Robert Frantz* /

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